

### **REMARKS**

This Application has been carefully reviewed in light of the Office Action dated May 16, 2008 ("*Office Action*"). At the time of the Office Action, Claims 1-5, 7, 8, and 10-32 were pending and Claims 17-28 were withdrawn. The Examiner rejects Claims 1-5, 7, 8, 10-16, and 29-32. Applicant amends Claims 1, 5, 10, 29, 31, and 32. Applicant submits that no new matter has been added by these amendments. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

### **Double Patenting**

The Examiner provisionally rejects Claims 1-5, 7, 8, and 10-16 under the judicially created doctrine of obviousness-type double patenting. Specifically, Claims 1-5, 7, 8, and 10-16 are rejected as being unpatentable over Claim 1 of copending Application No. 09/817,353 in view of U.S. Patent Application Publication No. 2002/0010634 A1 issued to Roman et al. ("*Roman*") and U.S. Patent Application Publication No. 2001/0032143 A1 issued to Haseltine ("*Haseltine*"). As this is a provisional double patenting rejection, Applicant defers the decision to file a terminal disclaimer or traverse the rejection until the Examiner has indicated that both the present Application and copending Patent Application 09/817,353 include allowable subject matter. However, Applicant stands willing to file a Terminal Disclaimer with respect to these claims in their current form upon indication of their allowability.

### **Section 103 Rejections**

The Examiner rejects Claims 1-2, 7-8, 13, 15, and 30-32 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,980,962 issued to Arganbright et al. ("*Arganbright*") in view of U.S. Patent No. 6,246,997 issued to Cybul et al. ("*Cybul*"). The Examiner rejects Claims 3-5, 10-12, 14, 16, and 29 under 35 U.S.C. 103(a) as being unpatentable over *Arganbright* in view of *Cybul*, in further view of U.S. Patent Application Publication No. 2002/0010634 issued to Roman et al. ("*Roman*") and Official Notice. Applicant requests reconsideration for the reasons discussed below.

**A. Claims 1-2, 7-8, 13, 15, and 30-32 are Allowable over the Proposed *Arganbright-Cybul* Combination**

Independent Claim 1 of the present Application, as amended, recites:

A method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of:

receiving, from a customer, an electronic request via a web access tool associated with the customer, the electronic request requesting to initiate return processing of merchandise having been purchased by the customer in a prior purchase transaction;

in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction;

displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise having been purchased by the customer in the prior purchase transaction;

receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing;

in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server; and

in response to receiving the electronic selection from the customer of the particular item of merchandise having been purchased by the customer in the prior purchase transaction, generating data for printing a return label for the particular item of merchandise selected by the customer.

Applicant respectfully submits that the cited references do not disclose, teach, or suggest the combination of elements recited in Applicant's Claim 1.

1. **The proposed combination does not disclose, teach, or suggest “in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction.”**

Applicant's Claim 1 recites “in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer, the transaction information identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction.” Thus, Applicant's claim recites a specific order to the steps of the claimed method. First an electronic request to initiate return processing is received and then in response to that request, a database is accessed to obtain transaction information identifying merchandise having been purchased by the customer. Applicant respectfully submits that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the features and operations recited in Applicant's claim.

In the *Office Action*, the Examiner relies upon Column 63, lines 8-11 of *Arganbright*, specifically, for disclosure of the recited claim elements. However, according to *Arganbright*, the process for handling returns begins when “the system presents the user with a copy of the satisfaction guarantee 2702.” (Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. As noted by the Examiner, *Arganbright* then discloses “[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). “If the user selects “return,” an online return form 2706 is presented to the user.” (Column 63, lines 12-13). “The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (Column 63, lines 13-17). Once the return form is populated by the customer's input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user's computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (Column 63, lines 23-29).

Applicant directs the Examiner's attention to the fact that after the user selects the return button, *Arganbright* only discloses that a form is provided for the user to fill out and print. The information used to populate the appropriate form is requested from the customer. Accordingly, to the extent that the Examiner relies on the selection of the "return" button in *Arganbright* as being analogous to Applicant's recited "electronic request requesting to initiate return processing," Applicant respectfully submits that there is no disclosure in *Arganbright* of **"in response to receiving the electronic request to initiate return processing from the customer, accessing a database to obtain transaction information associated with the customer . . . ,"** as recited in Applicant's Claim 1. To the contrary, *Arganbright* specifically states that the request and exchange forms are filled in by the user.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 7-8, 13, 15, and 30-31 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 32.

2. **The proposed combination does not disclose, teach, or suggest *"in response to receiving the electronic selection comprising the click on the particular item of merchandise in the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in a prior purchase transaction, the returns process initiated by a returns server."***

Applicant's Claim 1 recites "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server." Thus, Applicant's claim recites a specific order to the steps of the claimed method. First click on a particular item of merchandise previously purchased by a customer is received and then in response to that selection, a returns process for the selected item of merchandise is initiated by a returns server. Applicant respectfully

submits that the proposed *Arganbright-Cybul* combination does not disclose, teach, or suggest the features and operations recited in Applicant's claim.

As discussed above, *Arganbright* merely discloses that "[a]fter the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to "return" or "exchange" (box 2704) an item or plurality of items." (Column 63, lines 8-11). Thus, this portion refers to the selection of either a "return" button or an "exchange" button by a user. Applicants point out that the selection of the "return" button occurs before the user populates the form and before the user identifies a product by sku # for return. (Column 63, lines 12-22). As a result, the selection of the "return" button occurs before an item of merchandise is identified for return. The selection of a "return button" by the user before the identification of the product to be returned is not analogous to "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction," as recited by Applicant's amended Claim 1. Additionally, because there is no disclosure in *Arganbright* of any returns processing being initiated after the form is populated, *Arganbright* cannot be said to disclose that "the returns process [is] initiated by a returns server," as recited in Claim 1. For at least these reasons, *Arganbright* does not include "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server," as recited in Applicant's amended Claim 1.

*Cybul* does not cure the deficiencies of *Arganbright* identified above. *Cybul* relates to a system for online shopping that "takes advantage of the data already being gathered by POS systems on consumer shopping habits and preferences." (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor's POS system "supports a frequent shopper or loyalty program . . . [or] a database of historical purchase data indexed by loyalty customer," the information may be extracted from the vendor's POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can "efficiently find and

select the past shopping history of respective shoppers and import that data to the list builder's on-line historical purchase list database, thereby making it available for the shoppers' first and subsequent on-line shopping experiences." (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper's purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper's subsequent purchases on-line. *Cybul* does not at all relate to a returns process and, thus, does not disclose, teach, or suggest "in response to receiving the electronic selection comprising the click on the particular item of merchandise within the list of merchandise, initiating a returns process for the particular item of merchandise selected by the consumer from the list of merchandise purchased by the consumer in the prior purchase transaction, the returns process initiated by a returns server," as recited in Applicant's amended Claim 1.

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 7-8, 13, 15, and 30-31 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 32.

- 3. The proposed combination does not disclose, teach, or suggest "receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing."**

As another example of the deficiencies of the *Arganbright-Cybul* combination, Applicant respectfully submits that the cited references do not disclose, teach, or suggest "receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing," as recited in Claim 1. In the *Office Action*, the Examiner acknowledges that neither *Arganbright* nor *Cybul* disclose the recited claim elements. (*Office Action*, page 5).

However, the Examiner states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Arganbright* in view of *Cybul* to include an electronic selection from a displayed list of items to the consumer . . . in order to provide the consumer with a user friendly user interface and the convenience of performing on line shopping or e-commerce which include purchasing or returning merchandise.” (*Office Action*, page 5). Applicant respectfully disagrees and submits that Applicant’s recited step would not have been obvious to one of ordinary skill in the art in view of the disclosures of *Arganbright* and *Cybul*.

As discussed above, *Arganbright* discloses that the process for handling returns begins when “the system presents the user with a copy of the satisfaction guarantee 2702.” (Column 63, lines 3-5). Thus, the process initiates with the presentation of the return policy to the user. “After the user has a chance to review satisfaction guarantee 2702, the user selects whether the user wishes to “return” or “exchange” (box 2704) an item or plurality of items.” (Column 63, lines 8-11). Thus, the first electronic request received from the user relating to the return of a product is the selection of either a “return” button or an “exchange” button. “If the user selects “return,” an online return form 2706 is presented to the user.” (Column 63, lines 12-13). “The user is then requested to enter a plurality of information (box 2708) on return form 2706, including but not limited to, quantity, stock number or SKU, the reason for the return, product description, and an invoice number.” (Column 63, lines 13-17, emphasis added). Once the return form is populated by the customer’s input, the return form is “presented to the user in a format (box 2710) that can be printed on a conventional printer connected to the user’s computer” and that the user “is requested to print the form and include the form in the box containing the product or products to be returned.” (Column 63, lines 23-29). Thus, the form must be filled out by the customer and the transaction information is provided in the box of merchandise returned by the customer. Nothing is presented to the user that would be appropriate for selection by a click on a particular item of merchandise to identify that item for returns processing.

Even when considered in conjunction with the disclosure of *Cybul*, Applicant’s claim language would not have been obvious to one of ordinary skill in the art. *Cybul* relates to a system for online shopping that “takes advantage of the data already being gathered by POS

systems on consumer shopping habits and preferences.” (*Cybul*, Column 1, lines 36-38). Specifically, *Cybul* discloses that where a vendor’s POS system “supports a frequent shopper or loyalty program . . . [or] a database of historical purchase data indexed by loyalty customer,” the information may be extracted from the vendor’s POS system. (*Cybul*, Column 4, lines 25-34; Column 1, lines 63-65). As a result, a list builder tool can “efficiently find and select the past shopping history of respective shoppers and import that data to the list builder’s on-line historical purchase list database, thereby making it available for the shoppers’ first and subsequent on-line shopping experiences.” (*Cybul*, Column 4, lines 29-34). As such, *Cybul* merely discloses that a shopper’s purchases in a brick-and-mortar store are used to develop an online shopping list for that shopper’s subsequent purchases on-line.

Accordingly, at most the *Arganbright-Cybul* combination discloses that during an online purchase, a customer’s in store purchases may be used to efficiently develop an on-line shopping list. If an item were needed to be returned after the purchase is complete, the proposed combination merely discloses that a return form could be obtained on-line and filled out by the customer on the customer’s computer. The form would then be printed and placed in the box for shipping. It would not have been obvious to one of ordinary skill in the art to modify the return process of *Arganbright* and the purchase process of *Cybul* to result in Applicant’s recited step of “receiving an electronic selection, from the customer, via the web access tool, the electronic selection identifying a particular item of merchandise included in the list of at least one item of merchandise having been purchased by the customer in the prior purchase transaction, **the electronic selection comprising a click on the particular item of merchandise in the list displayed to the customer and identifying the particular item of merchandise for returns processing,**” as recited in Claim 1.

The principal evidence upon which the rejection of Claim 1 is based is the Examiner’s assertion that one of ordinary skill in the art would have been motivated of modify both the disclosure of *Arganbright* and the disclosure of *Cybul* to result in Applicant’s recited claim language. Applicant submits that such reasoning, without evidentiary support, is analogous to a reliance on common knowledge. Applicant respectfully reminds the Examiner, however, that the M.P.E.P. specifically states that “it is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal



evidence upon which a rejection was based." (M.P.E.P. § 2144.03, emphasis added). For at least these reasons, Applicant respectfully submits that the rejection of Claim 1 is clearly improper. If the Examiner continues to maintain the rejection of Claim 1 based on this reasoning, then Applicant hereby requests the Examiner to provide documentary evidence in the next Office Action, as stated in Section 2144.03(C) of M.P.E.P. Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant hereby requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (*See* Section 2144.03(C)-M.P.E.P.).

For at least these additional reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1, together with Claims 2, 7-8, 13, 15, and 30-31 that depend on Claim 1. For analogous reasons, Applicant also requests reconsideration and allowance of independent Claim 32.

**B. Claims 3-5, 10-12, 14, 16, and 29 are Allowable over the Proposed *Arganbright-Cybul-Roman-Official Notice* Combination**

First, Claims 3-4, 10-12, 14, and 16 depend upon independent Claim 1, which Applicant has shown above to be allowable. Accordingly, dependent Claims 3-4, 10-12, 14, and 16 are not obvious over the various combinations of references relied upon by the Examiner at least because Claims 3-4, 10-12, 14, and 16 include the limitations of Claim 1. Additionally, dependent Claims 3-4, 10-12, 14, and 16 recite further elements that distinguish Applicant's claims over the prior art of record. Since Applicant has shown independent Claim 1 to be allowable, however, Applicant has not provided detailed arguments with respect to Claims 3-4, 10-12, 14, and 16. Applicant remains ready to do so if it becomes appropriate.

Claim 5 has been rewritten in independent form to include the limitations recited in Claim 1 prior to any amendment in this Response to Office Action. Applicant respectfully submits that the proposed *Arganbright-Cybul-Roman-Official Notice* combination does not disclose, teach, or suggest the each and every element recited in Applicant's Claim 5, as previously and currently presented. For example, the proposed *Arganbright-Cybul-Roman-Official*

*Notice* combination does not disclose, teach, or suggest “accessing a database to obtain customer information about the customer, and wherein the displaying step includes displaying at least part of the customer information,” as recited in Applicant’s now independent Claim 5. In the *Office Action*, the Examiner acknowledges that *Arganbright* and *Cybul* do not disclose the recited operations and instead relies on *Roman*. However, the cited portion of *Roman* merely discloses that “[t]he ClickReturns.com system automatically analyzes the submitted return fro fraud and abuse against a proprietary database.” (*Roman*, paragraph 16). Specifically, *Roman* discloses that the types of fraud looked for include “frequency or abuse of an e-tailers established parameters within a specified time period,” “dummy shipping addresses, and “intent of repurchasing the same item at a discount at a later date.” (*Roman*, paragraph 16). There is no disclosure in the cited portion of “accessing a database to obtain customer information about the customer” and “displaying at least part of the customer information” in *Roman*.

In the *Office Action*, the Examiner states that the “offered replacement product . . . is read as part of the customer information since it will reference the initial product.” (*Office Action*, page 7). Applicant respectfully disagrees. *Roman* discloses upselling techniques are used to offer the consumer “a similar replacement product for purchase or exchange.” (*Roman*, paragraph 17). There is no disclosure that the initial product is displayed to the customer, as indicated by the Examiner and displaying a replacement product is not analogous to customer information and does not relate to the customer at all. Furthermore, Applicant notes that *Roman* actually discloses that “[t]he consumer is then asked a series of questions about the return.” (*Roman*, paragraph 15). The information requested from the consumer includes “receipt number, consumer’s name, phone number, description of the product being returned matching original transaction record collected . . . , condition of the product, such as original packaging, and working condition.” (*Roman*, paragraph 15). Thus, *Roman* merely discloses that the consumer provides consumer information to the processing system. There is no disclosure of “accessing a database to obtain customer information about the customer” and of “displaying at least part of the customer information,” as recited in Applicant’s now independent Claim 5.

For at least these reasons, Applicant requests reconsideration and allowance of Claim 5.

**No Waiver**

Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

**CONCLUSION**

Applicant has made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

The Commissioner is authorized to charge \$105.00 for an additional independent claim to Deposit Account No. 02-0384 of Baker Botts L.L.P. Although no other fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,  
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